

## **REMARKS/ARGUMENTS**

Claims 1-20 are under examination in the application. The Office Action mailed on June 5, 2007, includes the following rejections:

1. Claims 1, 2, 11-12 and 14-16 are rejected under 102(b) as being anticipated.
2. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated.
3. Claims 3-4 are rejected under 35 U.S.C. 103 as being anticipated.
4. Claim 5 is rejected under 35 U.S.C. 103 as being anticipated.
5. Claims 7-8 are rejected under 35 U.S.C. 103 as being anticipated.
6. Claim 10 is rejected under 35 U.S.C. 103 as being anticipated.
7. Claim 13 is rejected under 35 U.S.C. 103 as being anticipated.
8. Claim 20 is rejected under 35 U.S.C. 103 as being anticipated.

In an effort to advance prosecution the claims have been amended to further define the present invention and all amendments are fully supported by the specification as originally filed specifically the original claims and Figures 2 and 3. For example, claim 12 has been amended to further define one embodiment of the present invention and incorporates the limitation of claim 15.

### ***Finality of the Action***

Applicant requests reconsideration of the finality of the rejection of the last Office action, and the finality of that action be withdrawn. The Action presents entirely new references and new grounds for rejection, which the Applicant has not yet addressed. Applicant is fully aware that the rules no longer give to an applicant the right to amend as often as new references or reasons for rejection are presented; however, Applicant amended the claims merely to define further his invention and expedite prosecution of the application.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and **not be prematurely cut off in the prosecution of his or her application.** (See MPEP 706.0, emphasis added)

As it is in the interest of the Applicant, as well as in the interest of the public, that prosecution of the application be confined to as few actions as is consistent with a thorough consideration of its merits, Applicant only seeks to bring the prosecution to as speedy a conclusion as possible while receiving a full and fair hearing, and to develop a clear issue before appeal. Applicant respectfully request that the finality of the rejection be withdrawn.

***Claims 1-2, 11-12 and 14 are rejected under 35 U.S.C. § 102(b)***

The Action rejects claims 1-2, 11-12 and 14 under 35 U.S.C. § 102(b) as being as anticipated by Dorey, et al. (GB 2126211), which is said to disclose the claimed invention.

Dorey does not identically disclose every element of the claimed invention. See *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989). A reference that excludes a claimed element, no matter how insubstantial or obvious, is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983). For numerous reasons Dorey does not disclose each and every element of the present invention.

First, the material composition of Dorey is not the same as the present invention and could not function as the composition of the present invention. Specifically, Dorey is temperature stable to **ONLY 200°C** and at the **very most 250°C** (see Dorey lines 107-116).

Therefore, according to a first aspect of the present invention, there is provided a tong for use in a take-out in the manufacture of glassware, the tong having a jaw member comprising a thermoset composite of a particulate filler, a non-asbestos fibrous filler and a thermosetting resin, wherein each of the components of the composite is stable at temperatures up to 200°C.

Preferably, the components of the composite and stable at temperatures up to 250°C.

The process in which the present invention is used exceeded a temperature of 250°C, as such the compositions of Dorey cannot withstand the temperatures necessary for use in the present invention. Dorey does not identically disclose every element of the claimed invention because it cannot withstand a temperature of above 260°C since Dorey clearly states that the composite is stable up to 250°C. Simply, Dorey does not include a takeout holder having a plastic that provides a longer life expectancy and is stable at temperatures above 260°C.

Second, Dorey does not identically disclose every element of the claimed invention because the composition is stable only up to 200 or 250°C. The present invention provides a composition that is plastic and is stable at temperatures above 260°C. This difference in thermal stability is a direct result of physical properties of the respective composition. Therefore, given the different physical properties of the compositions of Dorey and the present invention the compositions cannot be identical. Since, the compositions withstand different temperatures they must include different components, Dorey cannot identically disclose every element of the claimed invention.

Third, Dorey does not identically disclose every element of the claimed invention because the composition does not disclose a pocket that is tapered with the front edge wider than the rear edge.

Finally, the composition of Dorey could not perform the same function as the present invention. Simply, the temperature stability of the composition of Dorey (e.g., 200°C to 250°C) cannot withstand the temperatures used in the present invention (in excess of 250°C). At temperatures above 250°C the composition of Dorey is not thermally stable and cannot perform the necessary function. As such, Dorey does not identically disclose every element of the

claimed invention.

The inventions cited in Dorey and the instant invention are different because of temperature stability differences, composition differences and functionality differences; therefore the reference does not identically disclose Applicant's claimed invention. Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. §102(b).

***Claim Rejections – Claims 17-19 are rejected under 35 U.S.C. § 102(b)***

The Action also rejects claims 17-19 under 35 U.S.C. § 102(b) as being as anticipated by Kume et al. (JP 04160065 A), which is said to disclose the claimed invention. However, as stated above a reference that excludes a claimed element, no matter how insubstantial or obvious, is enough to negate anticipation. See *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983); *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989). Kume does not **identically disclose every element** of the claimed invention.

Clearly, Kume does not **identically disclose every element** of the claimed invention. The present invention provides an insert for a takeout holder of ceramic. Kume discloses a ceramic mixture that is molded into a **sheet shape** to obtain an **insert sheet** for firing. Specifically, Kume discloses:

PURPOSE: To enable firing by which superior surface smoothness is ensured without causing sticking by dispersing and holding inorg. powder of a specified particle diameter in a sheet and/or on the surface of the sheet. CONSTITUTION: A mixture of 100 pts.wt. ceramic powder (e.g. alumina) of 0.01-10μm average particle diameter for forming a green sheet with 2-200 pts.wt. inorg. powder of 5-300μm average particle diameter and 5-100 pts.wt. org. binder is prep'd. and a dispersant, a plasticizer, a wetting agent, a releasing agent, a solvent, a defoaming agent, etc., are added to the mixture as required. This mixture is molded into a sheet shape to obtain an insert sheet for firing ceramic having 10-200μm surface roughness and 50-2,000μm thickness. The insert sheet is interposed between a firing table having high ruggedness and a ceramic molded body and firing is carried out.

It is unclear how the Kume abstract identically disclose every element of the ceramic insert for a takeout holder of the claimed invention. The Kume abstract makes absolutely no reference to an insert for a takeout holder. The mere use of the word "insert" and "ceramic" in the Kume

abstract does not equate to **identically disclosing every element** of the claimed invention. As stated in the Kume abstract “This mixture is molded into a sheet shape to obtain an insert sheet for firing” the shape of the product in Kume is a “sheet shape” and not an insert for a takeout holder.

Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. §102(b).

***Claim Rejections – Claim 3 is rejected under 35 U.S.C. § 103(a)***

The Action also rejects claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Dorey, et al. in light of Lloyd et al. (US 5,741,343). Applicant respectfully submits that claim 3 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

For the reasons stated above and incorporated herein, Dorey does not **identically disclose every element** of the claimed invention because Dorey does not include a takeout holder having a plastic that provides a longer life expectancy, a pocket that is tapered with the front edge wider than the rear edge and is stable at temperatures above 260°C. And as a direct contradiction to the present invention Dorey states that ceramic materials are unacceptable because they are brittle and easily chipped.

For Instance, ceramic materials have been used but these are brittle and easily chipped. A chipped ceramic jaw member eventually renders the takeout incapable of performing its function of picking up bottles (page 1, lines 77-82).

Similarly, Lloyd teaches against the use of plastics for high temperature applications of this sort as plastics are generally less well suited for this high temperature application. Lloyd also states that plastics typically have a relatively short service life even when specially formulated to withstand the high temperatures encountered in this hot end process. (see Column 1, lines 52-56). In addition, Lloyd teaches stacker bar pads with glass-contact surfaces that are roughened or serrated that are constructed to be attached to a metal support structure. Lloyd relates to stacker bar pads that undergo different strains, are exposed to different conditions, function in a different manner and are different from the takeout holder formed of plastic and the semi-circular nonmetallic insert of the present invention.

The combination of Dorey and Lloyd does not fulfill the requirements of 35 U.S.C. § 103(a). The combination does not provide each and every element of the present invention and would not work as the present invention. Lloyd teaches against the use of plastics because they cannot withstand the temperatures while Dorey teaches against the use of ceramic materials because they are brittle and easily chipped. The skilled artisan would not have looked to the combination of Dorey and Lloyd to address the problem of the present invention and given the teachings of Dorey and Lloyd the skilled artisan would have no indication that the combination would work. Their combination does not provide every limitation of the present invention the present invention.

The combination of Dorey and the stacker bar pads of Lloyd does not teach a takeout holder formed of plastic that provides a longer life expectancy and is stable at temperatures above 260°C AND a semi-circular, nonmetallic, **ceramic** insert. As a result, Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim Rejections – Claim 4 is rejected under 35 U.S.C. § 103(a)***

The Action also rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Dorey, et al. in light of Lloyd et al. (US 5,741,343) and further in view of Oberlin (U.S Patent 3,473,938). Applicants respectfully submit that claim 4 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

For the reasons stated above and incorporated herein, Dorey does not identically disclose every element of the claimed invention because Dorey does not include a takeout holder having a plastic that provides a longer life expectancy, a pocket that is tapered with the front edge wider than the rear edge and is stable at temperatures above 260°C. The addition of the stacker bar pads of Lloyd does not cure this deficiency for the reasons stated above, and incorporated herein. Similarly, the addition of alumina by Oberlin does not cure this deficiency.

The combination of Dorey, the stacker bar pads of Lloyd and the alumina by Oberlin does not teach a takeout holder formed of **plastic** that provides a longer life expectancy and is

stable at temperatures above 260°C AND a semi-circular, nonmetallic, **ceramic** insert, wherein the semi-circular, nonmetallic insert containing in part of alumina. Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim Rejections – Claims 5-6 are rejected under 35 U.S.C. § 103(a)***

The Action also rejects claims 5-6 under 35 U.S.C. § 103(a) as being unpatentable over Dorey, et al. in light of Lloyd et al. (US 5,741,343) and further in view of Nishikawa et al. (U.S Patent No. 4,900,807). Applicants respectfully submit that claims 5-6 are not obvious over the cited art and are, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

For the reasons stated above and incorporated herein, Dorey does not identically disclose every element of the claimed invention because Dorey does not include a takeout holder having a plastic that provides a longer life expectancy, a pocket that is tapered with the front edge wider than the rear edge and is stable at temperatures above 260°C. The addition of the stacker bar pads of Lloyd does not cure this deficiency for the reasons stated above, and also incorporated herein. Similarly, the addition of the teaching of Nishikawa does not cure this deficiency.

Nishikawa discloses polymers obtained by polymerizing a nitrile-terminated Schiff compound alone or together with other monomers. It is unclear how the addition of a nitrile-terminated Schiff compound polymer that may include clay will result in teaching a takeout holder having an insert formed in part of alumina - clay composite including a releasing agent. Not only does Nishikawa not provide ANY guidance as to how or what to combine the teachings of the references, it is unclear to the Applicant what the polymer of Nishikawa is supplying to the combination. Applicant assumes that the Action is attempting to combine the addition of clay to the polymer; however, the addition of a polymer and/or a clay polymer mix is irrelevant to the present disclosure. A polymer having clay is entirely different from a ceramic composed in part of alumina - clay composite including a releasing agent.

Regardless, the addition of Nishikawa to the combination of Dorey and Lloyd fails to teach each and every limitation of the present invention. The combination of does not teach a

takeout holder formed of **plastic** that provides a longer life expectancy and is stable at temperatures above 260°C **AND** a semi-circular nonmetallic **ceramic** insert composed in part of alumina - clay composite including a releasing agent. Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim Rejections – Claims 7-9 are rejected under 35 U.S.C. § 103(a)***

The Action also rejects claims 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Dorey, et al. in light of Lloyd et al. (US 5,741,343) and further in view of Denney et al. (U.S Patent No. Re. 34,953). Applicants respectfully submit that claims 7-9 are not obvious over the cited art and are, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

For the reasons stated above and incorporated herein, Dorey does not **identically disclose every element** of the claimed invention because Dorey does not include a takeout holder having a plastic that provides a longer life expectancy, a pocket that is tapered with the front edge wider than the rear edge and is stable at temperatures above 260°C. The addition of the stacker bar pads of Lloyd does not cure this deficiency for the reasons stated above, and also incorporated herein. Similarly, the addition of the teaching of Denney does not cure this deficiency.

Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim Rejections – Claim 10 is rejected under 35 U.S.C. § 103(a)***

The Action also rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Dorey, et al. in light of Lloyd et al. (US 5,741,343) and further in view of Denney et al. (U.S Patent No. Re. 34,953) and further in view of Recker et al. (U.S Patent No. 6,523,768). Applicants respectfully submit that claim 10 is not obvious over the cited art and are, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

For the reasons stated above and incorporated herein, Dorey does not **identically disclose every element** of the claimed invention because Dorey does not include a takeout holder having

a plastic that provides a longer life expectancy, a pocket that is tapered with the front edge wider than the rear edge and is stable at temperatures above 260°C. The addition of the stacker bar pads of Lloyd does not cure this deficiency for the reasons stated above, and also incorporated herein. Similarly, the addition of the teaching of Denney does not cure this deficiency.

Recker discloses a rotor assembly for comminuting [i.e., to reduce to minute particles, pulverize; to triturate; to grind] scrap wood and other like material has a rotor drum including a drive shaft and at least one radially projecting tool supporting member with a tool assembly receiving pocket. Recker does not teach the “wedge effect” of the present invention and could not function as the present invention. Specifically, Recker provides a 2 piece device (see Figure 5 illustrating that includes a tool or tool insert 26, and a wedging insert holder 28) that is inserted separately to fit into the aperture and bolt 100 is adjusted to move the wedging insert holder and tighten the tool insert. To function correctly, a spacer block or step 60 is needed with a width that is narrower than the width of the tool insert 26 at its base so as not to interfere with the operation of the insert holder 28 (see column 4, lines 14-25).

This structure is not present in the present invention and could not function in the present invention. Recker requires a 2 piece design, a tightening bolt, and a spacer block, all of which are missing from the present invention. Furthermore, the use of the design of Recker is not applicable to the present invention given the differences in the thermal expansion coefficients of the various materials used in Recker.

Regardless, the addition of Recker to the combination of Dorey, Lloyd and Denney fails to teach each and every limitation of the present invention. The combination of does not teach a takeout holder formed of **plastic** that provides a longer life expectancy and is stable at temperatures above 260°C AND a semi-circular, nonmetallic, **ceramic** insert composed in part of alumina - clay composite including a releasing agent. Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim Rejections – Claim 13 is rejected under 35 U.S.C. § 103(a)***

The Action also rejects claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Dorey, et al. in light of Mohler et al. (U.S 6,805,832). Applicants respectfully submit that claim 10 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

For the reasons stated above and incorporated herein, Dorey does not identically disclose every element of the claimed invention because Dorey does not include a takeout holder having a plastic that provides a longer life expectancy, a pocket that is tapered with the front edge wider than the rear edge and is stable at temperatures above 260°C.

Mohler discloses a thermite torch cutting nozzle that is fabricated from a material selected from the group consisting of mineralphenolic and high temperature plastic. At the very most Mohler discloses the “...mineral/phenolic. High temperature plastics, such as glass-filled polyetheretherketone, may also be used for such nozzles” (see column 4, lines 23-25; emphasis added). However, Mohler provides no guidance to any parameters compositions or specifics other than the use of the term mineral/phenolic and glass-filled polyetheretherketone.

The combination of Dorey and Mohler does not teach a takeout holder formed of plastic with a plastic that provides a longer life expectancy and is stable at temperatures above 260°C. Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim Rejections – Claim 20 is rejected under 35 U.S.C. § 103(a)***

The Action also rejects claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Kume et al. (JP 04160065 A) as applied to claim 20 above, in view of Filges et al. (U.S Patent 6517597). Applicants respectfully submit that claim 20 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, Kume does not identically disclose every element of the claimed invention. The present invention provides an insert for a takeout holder

of ceramic. Kume discloses a ceramic mixture that is molded into a sheet shape to obtain an insert sheet for firing. The addition of a glaze by Filges does not cure this deficiency.

The combination of Kume and Filges does not teach a takeout holder formed of plastic with a plastic that provides a longer life expectancy and is stable at temperatures above 260°C. Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

**Conclusion**

In light of the remarks and arguments presented above, Applicant respectfully submits that the claims in the Application are in condition for allowance. Favorable consideration and allowance of the pending claims 1-20 are therefore respectfully requested. If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: August 6, 2007.

Respectfully submitted,



---

Chainey Singleton  
Reg. No. 53,597

ATTORNEY FOR APPLICANTS

Customer No. 34,725  
Chalker Flores, LLP  
2711 LBJ FRWY, Ste. 1036  
Dallas, TX 75234  
214.866.0001 Telephone  
214.866.0010 Facsimile